



## UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/046,933	10/26/2001	Timothy R. Bratton	REAL-2007115(RN113)	8588
61857	7590	05/05/2010		
AXIOS LAW GROUP, PLLC / REALNETWORKS, INC				
1525 4TH AVE, STE 800				
SEATTLE, WA 98101-1648				
EXAMINER				
SHERR, CRISTINA O				
ART UNIT		PAPER NUMBER		
3685				
NOTIFICATION DATE		DELIVERY MODE		
05/05/2010		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patents@axioslaw.com

ADAM@AXIOSLAW.COM

### Office Action Summary

**Application No.**

10/046,933

**Applicant(s)**

BRATTON ET AL.

**Examiner**

CRISTINA SHERR

**Art Unit**

3685

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 January 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12, 14-36, 38 and 51-60 is/are pending in the application.
- 4a) Of the above claim(s) 9-12, 14, 32-36, 38, 51 and 52 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 15-31 and 53-60 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This Office Action is in response to Applicant's Supplemental Amendment filed January 21, 2010. Claims 1-12, 14-36, 38, and 51-60 are pending in this case. Claims 1-4, 6, 8, 15-22, 26, and 53 are currently amended. Claims 9-12, 14, 32-36, 38, and 51-52 are withdrawn. Claims 13, 37, and 39-50 are canceled. Accordingly, claims 1-8, 15-31, and 53-60 are under examination.

### ***Response to Arguments***

2. Applicant's arguments filed September 30, 2009, regarding the section 101 rejection of claims 1-8 and 15-31, as currently amended, have been fully considered but they are not persuasive.
3. Claim 1, as amended, recites creating a file which somehow combines or interleaves first and second data elements without specifying who or what creates and combines. Thus, independent claim 1 and its dependent claims 2-8 are rejected under 35 U.S.C. §101.
4. Independent claim 15, as amended, recites a "media client", which is interpreted as software or computer program and which is configured by certain instructions without actually being caused to perform any steps. Thus, independent claim 15 and its dependent claims 16-25 are rejected under 35 U.S.C. 101.
5. Independent claim 26 recites reception means, and media assembly means in a device or apparatus. Using the broadest reasonable interpretation of "means", the claimed means are interpreted as software only, and thus independent claims 26 and its dependent claims 27-31 are rejected under 35 U.S.C. 101.

6. Applicant's arguments with respect to the section 112 rejection of claims 1-8 have been considered but are moot in view of the new ground(s) of rejection.
7. Applicant's arguments with respect to the section 103 rejections of claims 1-8, 15-31, and 53-60, as currently amended, have been considered but are not persuasive. Applicants argue regarding claims 1, 15, 26, and 53, as currently amended, that nothing in the cited prior art teaches discloses or suggests "interleaving, according to a predetermined algorithm, portions of at least some of the first multiplicity of encoded-media-data portions from the first data file and at least some of the second multiplicity of encoded-media-data portions from the second data file to assemble . . ." We note that the specification does not support "interleaving as a way to assemble files.

#### ***Remarks***

8. Note that the recitation regarding data being "unusable as the media . . ." constitutes descriptive material and thus will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983), *In re Ngai*, 70 USPQ2d (Fed. Cir. 2004), *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01 II.

#### ***Claim Rejections - 35 USC § 101***

9. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

10. Claims 1-8 and 15-25 are rejected under 35 U.S.C. 101.
11. In this case, claims 1-8 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court

precedent (See also *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) and recent Federal Circuit decisions, a §101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In addition, the tie to a particular apparatus, for example, cannot be mere extra-solution activity. See *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

12. In this case, specifically, claim 1 recites creating a file which somehow combines or interleaves first and second data elements without specifying who or what creates and combines. Thus, independent claim 1 and its dependent claims 2-8 are rejected under 35 U.S.C. §101.

13. Under the broadest reasonable interpretation standard, claims 15-31 recite a computer program only. "Computer programs claimed as computer listings per se, *i.e.*, the descriptions or expressions of the programs, are not physical 'things.' They are neither computer components nor statutory processes, as they are not 'acts' being performed." MPEP §2106.01 I. Because the claims recite only abstractions that are neither "things" nor "acts," the claims are not within one of the four statutory classes of invention.<sup>1</sup> Because the claims are not within one of the four statutory classes of invention, the claims are rejected under 35 U.S.C. §101.

---

<sup>1</sup> 35 U.S.C. §101 defines four categories of inventions that Congress deemed to be the appropriate subject matter of a patent; namely, processes, machines, manufactures and compositions of matter. The latter three categories define "things" (or products) while the first category defines "actions" (*i.e.*, inventions that consist of a series of steps or acts to be performed).

14. Independent claim 15, as amended, recites a "media client", which is interpreted as software or computer program and which is configured by certain instructions without actually being caused to perform any steps. Thus, independent claim 15 and its dependent claims 16-25 are rejected under 35 U.S.C. 101.

15. Independent claim 26 recites reception means, and media assembly means in a device or apparatus. Using the broadest reasonable interpretation of "means", the claimed means are interpreted as software only, and thus independent claims 26 and its dependent claims 27-31 are rejected under 35 U.S.C. 101.

***Claim Rejections - 35 USC § 112***

16. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

17. Claims 1-8, 15-31, and 53-60, as currently amended, are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

18. Specifically, independent claims 1, 15, 26, and 53, as currently amended recite "interleaving, according to a predetermined algorithm, portions of at least some of the first multiplicity of encoded-media-data portions from the first data file and at least some of the second multiplicity of encoded-media-data portions from the second data file to assemble . . ." We note that the specification does not support "interleaving as a way to

assemble files. For purposes of examination, the claims are being interpreted as follows: assembling portions of at least some of the first multiplicity of encoded-media-data portions from the first data file and at least some of the second multiplicity of encoded-media-data portions from the second data file to assemble a renderable contiguous portion of the media file by the electronic device

19. Thus claims 1-8, 15-31, and 53-60, are rejected under 35 U.S.C. 112, first paragraph.

20. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

21. Claims 1-8, 15-31, and 53-60 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In this case, claims 1, 3, 7, 15, 17, 18, 26, 28, 29, 31, 53, 55, and 59, as currently amended, recite data portions from "non-contiguous" intervals. The term "non-contiguous" is unclear, given that digital data cannot be physically contiguous, and so the claims do not further define the invention. Thus claims 1-8, 15-31, and 53-60 are rejected under 35 U.S.C. 112, second paragraph.

***Claim Rejections - 35 USC § 103***

22. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

23. Claims 1-8, 15-31, and 53-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mages et al (6,185,306) in view of Hazra (US 6,510,553), further in view of Reitmeier et al (US 7,457,415).

24. Regarding claims 1, 15, 26, and 53 –

25. Mages discloses a method comprising:

receiving by the electronic device a first data file from a first computing device via a first communication channel, wherein the first data file comprises a first multiplicity of encoded-media-data portions from a first multiplicity of non-contiguous intervals spaced throughout the media file, the first data file being unusable as the media file based at least in part on a lack of a second multiplicity of encoded-media-data portions from a second multiplicity of non-contiguous intervals spaced throughout the media file; (See 306 Figs. 3-3, and 12, Col. 4, lines 1-65, Col. 8, lines 30-50, Col. 10, lines 1-30 and claims 1-8, col 8 ln 21-23);

receiving by the electronic device a second data file, wherein the second data file and comprises the second multiplicity of encoded-media-data portions from the second multiplicity of non-contiguous intervals spaced throughout the media file, the second data file being unusable as the media file based at least in part on a lack of the first multiplicity of encoded-media-data portions; (col 8 ln 50- col 9 ln 15, and col 7 ln 8-10 where the "header-trigger or other file" is stored at a server, and sent to the end-user computer so that the audio or video file may be played back) and



assembling portions of at least some of the first multiplicity of encoded-media-data portions from the first data file and at least some of the second multiplicity of encoded-media-data portions from the second data file to assemble a renderable contiguous portion of the media file by the electronic device. (col 8 ln 20- col 9 ln 15 where the "header-trigger or other file" is stored at a server, and sent to the end-user computer so that the audio or video file may be played back.)

26. Mages does not specifically disclose removing at least one portion from each of a plurality of locations within the media file. However, as above, Mages discloses, at col 6 ln 39-43, content may be crippled by removing critical information *such as* the video-audio header. (emphasis added). Note that the term "such as" indicates that the header is merely one example of critical information to remove. Further, Mages recites that "it is possible to 'cripple' . . . by means other than deleting the header thereof." (col 8 ln 21-23). Thus, it would be a predictable result that other critical information could and would do the trick. *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (U.S. 2007).

27. Additionally, Mages does not disclose having a plurality of second file portions wherein each may be received without reference to the content of the others.

28. Reitmeier does disclose removing at least one portion from each of a plurality of locations within the media file (col 1 ln 62-col 2 ln 20, col 2ln 45-55, col 4 ln 5-30col 4 ln 55 - col 5 ln 5, col 6 ln 5-35).

29. Hazra discloses having a plurality of second file portions (e.g. col 4 ln 18-40), wherein each may be received without reference to the content of the others (e.g. col 8 ln 54 – col 9 ln 15).

30. It would be obvious to one of ordinary skill in the art to combine the teachings of Mages, Reitmeier, and Hazra motivated by the desire for a faster transmission, as well as by the need to avoid "choppy" playing of media without sacrificing data security.

31. Regarding the wireless limitations of claims 2, 16, 21, 22, 27, and 54 Mages teaches receiving a second data file with an electronic device. (col 8 ln 50- col 9 ln 15). Further, with respect to the wireless device that it is not regarded as inventive to merely make an old device portable or movable without producing any new and unexpected result. *In re Lindberg*, 93 USPQ 23 (CCPA 1952). Further, Official Notice is taken that it is old and well-known to disconnect once transmission is complete, since there would no further need for the connection at that point and in order to prevent further charges.

32. Regarding limitations of claims 3, 4, 17, 23, 25, 28, 29, 56 and 55 -

33. Mages et al (See 306 Figs. 3-3, and 12, Col. 4, lines 1-65, Col. 8. lines 30-50, Col. 10, lines 1-30 and claims 1-8) disclose playing media files from two portions, each of which is unusable as a media file and each of which is delivered via a separate channel that is the equivalent of the claim limitations.

34. Regarding the component limitations of claim 5, 24 and 57

35. The references do not specifically disclose the use of synch cradles or docking stations. Official notice is taken that such devices are old and well known. Further, it

has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *In re Dulberg*, 129 USPQ 348, (CCPA 1961).

36. Regarding transmission limitations of claim 6 and 58 --

37. Mages et al (See 306 Figs. 3-3, and 12, Col. 4, lines 1-65, Col. 8. lines 30-50, Col. 10, lines 1-30 and claims 1-8) disclose playing media files from two portions, each of which is unusable as a media file and each of which is delivered via a separate channel that is the equivalent of the claim limitations.

38. Regarding the limitations of claims 7, 18, 30, 31, and 59

39. Mages et al (See 306 Figs. 3-3, and 12, Col. 4, lines 1-65, Col. 8. lines 30-50, Col. 10, lines 1-30 and claims 1-8) disclose playing media files from two portions, each of which is unusable as a media file and each of which is delivered via a separate channel that is the equivalent of the claim limitations.

40. Regarding key limitations of claims 8, 19, and 60

41. Mages et al (See 306 Figs. 3-3, and 12, Col. 4, lines 1-65, Col. 8. lines 30-50, Col. 10, lines 1-30 and claims 1-8) disclose playing media files from two portions, each of which is unusable as a media file and each of which is delivered via a separate channel that is the equivalent of the claim limitations because uncrippling is based on employing a key.

### ***Conclusion***

42. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

43. Milestones in AT&T History, at <http://www.corp.att.com/history/milestones.html>

44. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

45. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

46. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CRISTINA SHERR whose telephone number is (571)272-6711. The examiner can normally be reached on 8:30-5:00 Monday through Friday.

47. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin L. Hewitt, II can be reached on (571)272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

48. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

CRISTINA OWEN SHERR  
Examiner  
Art Unit 3685

/Calvin L Hewitt II/  
Supervisory Patent Examiner, Art Unit 3685